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Off. of Offield & Linthicum for Respondent.

Supreme Court of the United States.

Filed Oct. 19, 1898.

OCTOBER TERM, A. D. 1898.

STOVER MANUFACTURING COMPANY,
Appellant,
vs.
MAST, FOOS & COMPANY,
Appellee.

From the U. S. Circuit Court of Appeals for the Seventh Circuit.

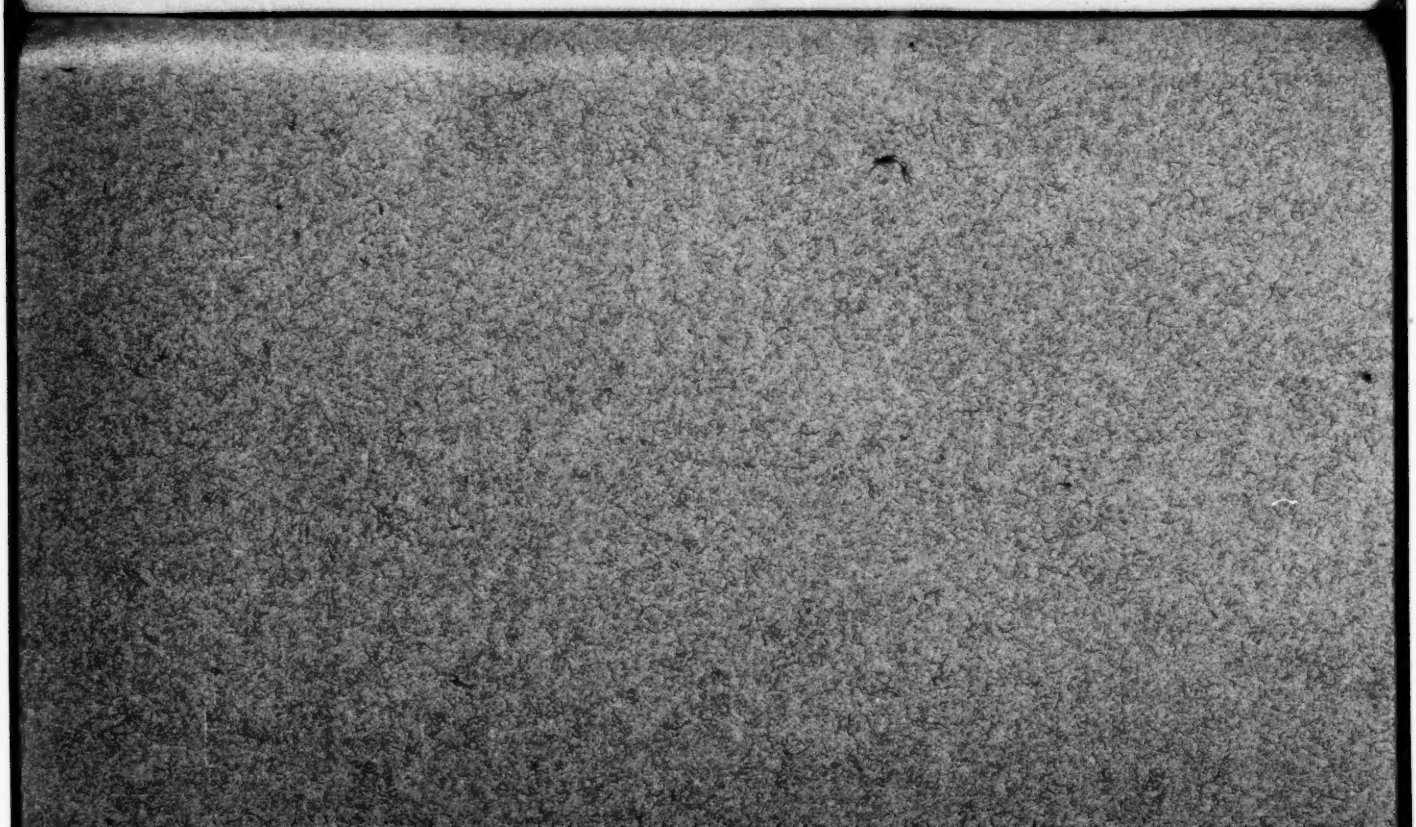
No. 430.

Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the Seventh Circuit.

Brief and Argument in Opposition to Motion and Petition.

By
CHARLES K. OFFIELD and
CHARLES C. LINTHICUM.

C. G. Burgoyne, Walker and Centre Streets, N. Y.



Supreme Court of the United States.

OCTOBER TERM, A. D. 1898.

STOVER MANUFACTURING CO., Appellant, vs. MAST, FOOS & COMPANY, Appellee.	From the U. S. Circuit Court of Appeals for the Seventh Circuit. No. 486.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF AND ARGUMENT IN OPPOSITION TO MOTION AND PETITION.

By Charles K. Offield and Charles C. Linthicum.

Upon the 26th day of July, 1898, at the October Term, 1897, of the United States Circuit Court of Appeals for the Seventh Circuit, a decree of the United States Circuit Court for the Northern District of Illinois, by Judge GROSSCUP, heretofore entered in said court, finding valid certain Letters Patent of the United States granted one Samuel M. Martin under date of August 5, 1890, and numbered 433,531, for an alleged improvement in windmills, and finding that

defendant infringed said letters patent and granting an interlocutory injunction thereunder, was reversed with costs, and said cause "remanded to the said Circuit Court with directions to dismiss the bill for want of equity" (Record, p. 602), the first claim only of said letters patent being involved.

The opinion filed in the Circuit Court of Appeals for the Seventh Circuit in this cause, in accordance with which said order was entered, is the opinion of the entire Court, without conflict or dissent as to any of its members, either as to conclusions arrived at or reasoning as to such conclusions.

The complainant in that litigation, Mast, Foos & Company, now presents its petition for writ of *certiorari* to this Court, asking a review and reversal of such Court of Appeals finding and judgment; and it is against the recognition and granting of this petition, or any relief thereunder, that this defendant in error, the Stover Manufacturing Co., most earnestly protests and strenuously objects, principally for the following reasons:

POINT I.

The record in this case shows that there is nothing whatever unusual connected with this litigation, and nothing disclosed by this record except those matters and things which arise in every hostile and persistently defended patent cases carried on in different Federal Circuits. No new question of law or fact, or even practice, is here present. If this petition is granted in this case it will simply be opening wide the floodgates of the entire volume of patent litigation in this country, and the downpour of cases into this court from every circuit, by every defeated litigant in a patent case, will be certain, swift and continuous. That such a con-

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dition was not contemplated by the act under which the granting of this writ is invoked, and that such act will not be permitted by this Court, to be used to bring about such condition, seems to be clearly apparent from the decisions and acts of this Court since the existence of the enactment, by authority of which the possibility for the presentation of this petition exists.

It would seem that all that is necessary to assure a denial of this petition is found upon the face of the petition itself, such petition showing that the Circuit Court of Appeals for the Seventh Circuit has in no respect enunciated a single erroneous principle of law or fact in reaching the conclusions upon which this petition must be based as to asserted error. The most that can be said or has been said by petitioners as to such Court of Appeals is that, in the opinion of petitioning counsl, certain established principles and rulings of this Court in patent causes have been either *overlooked, misapplied or disregarded by that court.*

As bearing upon the question in what light this Court will look upon an effort to invoke this writ of *certiorari* to review and reverse the judgment of a Circuit Court of Appeals settling a question of a personal fight between two litigants in a patent or any case, the decision of this Court in the case of *in re* Woods, 143 U. S., 206, would seem to be strongly indicative if not conclusive ; we quote :

" In the matter of Law Ow Beu, the construction of " acts of Congress in the light of treaties with a foreign " government, and the status of domicile in respect of " natives of one country domiciled in another, a matter " of international concern, were brought under consider- " ation upon the record, and we were of opinion that the " grounds of the application were sufficient to call for " our interposition.

" But we do not regard the inquiry as to whether it " was settled law in the State of Minnesota that a judg- " ment of dismissal in a former suit, such as pleaded " here, was not a bar to a second suit upon the same

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" cause of action, or whether the law in respect to " recovery by a servant against his master for injuries " received in the course of his employment was prop- " erly applied on the trial of this case, as falling within " the category of questions of such gravity and general " importance as to require the review of the con- " clusions of the Circuit Court of Appeals in reference " to them."

While we recognize that no hard and fast rule has or can be laid down by this Court as a fixed guide or condition precedent for the granting of this writ, this Court has pointed out certain conditions which must exist as a quality or condition precedent to the granting of the writ—in fact, that the power and authority to grant this writ " has been held to be a branch of its juris- " diction which should be exercised sparingly and with " great caution and only in cases of peculiar gravity " and general importance or in order to secure " uniformity of decision."

Law Ow Beu's cases, 141 U. S., 583, 144 U. S., 47.
In re Woods, 143 U. S., 202.

The above quoted sentence is from the decision of this Court in the case of *Amer. Construction Company vs. Jacksonville Ry.*, 148 U. S., 383, such decision being rendered at the March term, 1893, the Court then saying that " accordingly while there " have been many applications to this Court for " writ of *certiorari* to the Circuit Court of Ap- " peals under this provision, two only have been " granted." A search through the reports of this Court from the date of this decision to the present time shows that out of the large number of such petitions presented that only two or three of such petitions have since been granted, and that such granted petitions have been entirely within the spirit and identification, as to subject matter, of the cases above cited.

The subsequent case of " The Conqueror," 166 U. S., 110, where the writ of *certiorari* was granted, involved,

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as one of its principal questions, whether a foreign-built ship, purchased and owned by a citizen of the United States, and brought by him to these waters, was taxable under the tariff laws. Truly, indeed, a question of "*peculiar gravity and general importance.*"

The cases of *Smith vs. Vulcan Iron Works* and *Norton vs. Wheaton*, 165 U. S., 518, brought in alignment the clash of the various decisions in the several Courts of Appeal of the nine circuits, relating to the power of the Circuit Court of Appeals to consider and decide whole case on the merits, on an appeal from an interlocutory decree granting an injunction and accounting in a patent case, and came clearly within the rule of this Court above cited, of the granting of the *certiorari* writ "*in order to secure uniformity of decision*" on a question of law or practice between two conflicting Courts of Appeal.

It is our contention that there is not a fact nor condition in this record and petition presented that brings this petition and case within the letter, spirit or intention of either of the above decisions, or of any fair construction that can be put upon the statute itself.

POINT II.

The fact that the opinion of the Circuit Court of Appeals for the Seventh Circuit is adverse to the majority opinion of the Court of Appeals of the Eighth Circuit immaterial in this case.

We respectfully submit that the fact that the unanimous opinion and finding of the Court of Appeals for the Seventh Circuit differs from, and is hostile to, the opinion and finding of the majority Judges of the Court

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of Appeals for the Eight Circuit, is without relevancy or force in determining any question here present. Instances have arisen and will undoubtedly continue to arise, where some great principle of law is at stake, or some mixed question of law or fact, in relation to which the Circuit Courts of Appeals of the different circuits disagree and are in hostile conflict; and such questions are of such great gravity and general importance as will induce this Court to review and consider the same. But to give any force or effect to the contention that this Court can be called upon to decide these questions by writ of *certiorari*, it must appear, we take it, that the conflicting opinions and findings of the different circuits are upon the same question of law and upon the same question of fact.

It appears on the face of the different opinions here present that no such conditions exist in the records here presented; the Circuit Court of Appeals for the Eighth Circuit not being unanimous as to their opinions or findings—a majority opinion of the Court only harmonizing—and the opinion of Judge THAYER, even upon the mutilated record present in the Eighth Circuit, being in harmony with the opinion and finding of the Seventh Circuit herein complained of.

POINT III.

But one claim of the patent involved; the validity and value of the patent, otherwise not being disturbed.

The patent in suit has three claims, and but one of such claims is involved in this litigation. We respectfully submit that a litigation which involves only one claim of a patent cannot in itself be of such "peculiar

gravity and general importance" as will give to the litigant the right to be heard in this Court, even where two Circuit Courts of Appeal differ as to the construction of such claim, or as to any asserted fact of infringement thereof. Nearly all patents issued have large numbers of claims, upon which suits can be founded independently against different parties as infringers of each claim respectively, and it would be a curious interpretation of the law that would contemplate a right of appeal to the Supreme Court of the United States to determine the validity and scope of these multitudinous and nebulous claims, whenever two Circuit Courts of Appeal happened to differ as to such matters, even upon the same records and conditions of fact.

Of course, patents have existed and will exist representing basic and valuable inventions, where the principal value of the patent resides in a single claim; as, for example, the fifth claim of the Bell Telephone Patent—the transmission of articulate speech by the electrical current. In such cases, such single claim might represent the peculiar gravity and general importance contemplated by the decisions of this Court. But we take it that no such assertion can be made for the fragmentary and inconsequential claim of the patent under discussion in this record.

POINT IV.

The whole subject matter of the first claim of the patent in suit; trivial and of slight importance.

It appears by the record in this case that, at the lowest estimation, but five per cent. of the windmill

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output of all the various manufactures of this country contain any device that even the complainant petitioner in this case can contend infringes such first claim. It appears also that the largest windmill manufacturers in the United States do not, and will not, employ the device of the first claim in their windmill output, the record showing only 3,000 windmills having ever been made containing the asserted device of the first claim of the patent in suit.

Can it be contended for a moment that a patented device, whose desirability is so questionable, and which, for the period of nearly a decade of years, has been unable to no further impress itself upon the industry to which it relates, represents a subject-matter of such peculiar gravity and general importance as to secure a recognition for solution at the hands of this court ?

Even if the liberul royalty of one dollar per windmill could be conceded as allowable under the first claim of this patent, even then only a few thousand dollars at the utmost is involved in this whole litigation.

POINT V.

The opinions of the two Circuit Courts of Appeal ; in reality not in conflict.

It is clearly apparent from the reading of the majority opinion of the Circuit Court of Appeals for the Eighth Circuit that such opinion is founded upon two conditions present, or assumed to be present, in the record of the case of that circuit, namely :

1. That the device of the first claim of Martin's Patent went into wide adoption and general use, and

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practically superseded all other devices in use for the same purpose in wind mills, with the attending beneficial results cited in the opinion.

2. That invention and patentable novelty was found in the first claim of the Martin Patent by reason of the fact that in no prior patent or publication had an internal gear of any description ever been exhibited for any purpose in a windmill.

The majority opinion and decree of the Circuit Court of Appeals for the Eighth Circuit was founded upon these two assumptions, and such assumptions exist as a condition precedent to the finding of the opinion. Of course, the conclusion is natural and irresistible, that, if neither of these conditions had been admitted or present in the Eighth Circuit, the dissenting opinion of Judge THAYER would have been the unanimous decision of the Court of Appeals.

In the case of the rendered opinion of the Circuit Court of Appeals of the Seventh Circuit the actual truths represented by the two asserted conditions, were fully proven, as facts, namely: It was proven affirmatively, without question, cavil or criticism:

1. That at the lowest estimate only five per cent., and at the highest estimate only fifteen per cent. of all the windmills manufactured by the various manufacturers of the United States contained any device that could, by any possibility, be contended, came under the asserted first claim of the patent in suit.

2. It was proven, indisputably, without room for explanation or evasion, that various letters patent of the United States had been granted, disclosing the use of internal gears, both identically and substantially like the Martin Patent in suit in various parts of a windmill structure; and an illustrated publication of the Perkins windmill, not disputed, but admitted, showed the application in use of internal gears in the head of a windmill at precisely the same point of application as disclosed by the Martin Patent.

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These facts are exhibited in this petition and brief (pp. 47, 48), and in the record (pp. 588, 594-5-6).

We respectfully submit that the opinion of the Circuit Court of Appeals of the Eighth Circuit, being founded upon the concealment or absence of such facts in the record of the Eighth Circuit, and the opinion of the Circuit Court of Appeals for the Seventh Circuit being founded upon the presence and undisputed existence of such facts in that record; there is, as a matter of fact, no conflict between the opinions of the two courts; and it is evident that the opinion and finding of the Circuit Court of of Appeals for the Eighth Circuit would have been in entire harmony and alignment with the opinion and finding of the Circuit Court of Appeals for the Seventh Circuit, upon the same record of the case, in that circuit.

POINT VI.

The fact that the Circuit Court of Appeals for the Seventh Circuit dismissed the complainant petitioner's bill of complaint for want of equity—no ground for the granting of this petition.

If the appeal from the decree of the Circuit Court had been from an interlocutory injunction upon final hearing, there could be no contention but that the Court of Appeals for the Seventh Circuit had a perfect right to consider and decide the whole case upon the merits.

Smith vs. Vulcan Iron Works, 165 U. S., 518.

It is the contention, however, of the petitioner com-

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plainant that the merits of the case could not be decided by the Court of Appeals, except upon final hearing and the appearing of all the facts upon full testimony taken. We respectfully submit that such position is untenable, and is without reason or logic, under such conditions of fact as appear in this case.

This Court has frequently decided that the question of patentable novelty, which is really the only question decided in the Court of Appeals for the Seventh Circuit, can be determined on the face of the patent itself without testimony of any description, and simply upon the interposition of a demurrer to determine such fact.

Richards vs. Chase Elevator Co., 159 U. S., 477.

The cases are numerous in this Court also, where this question of patentable novelty, has been determined by the presence in the record of antecedent patents in the same industry, to which the patent asserted related, and such fact of patentable novelty has been determined by a comparison and analysis between the patent in suit and the old exhibited art. There is no testimony where such facts are perfectly plain on the face of the different exhibits that can alter or throw light on the fact itself. In the present case the various patents and publications, showing the presence of internal gears in various parts of windmills long prior to the patent in suit, show clearly to the Court that such patent in suit as to its asserted claim was without semblance of patentable novelty or invention; and why, under these facts and conditions, has not the Court a right to so find and determine, without the long, tedious, expensive, and foolish procedure of taking testimony as to a matter which is apparent on the face of the papers themselves, and which no amount of testimony could possibly alter?

Again, it is undisputed in the record present in the Court of Appeals of the Seventh Circuit, that the entire wind-mill output of the United States does not

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contain more than fifteen per cent. at the farthest of the devices of the single relied upon claim of the patent in suit, and what possible benefit or reason is there in sending the case back to the Circuit Court, simply to take testimony to prove a fact that is not disputed in this case?

The right and duty of a Circuit Court of Appeals to dismiss a case upon the merits, when brought to that Court, on an appeal from a preliminary injunction founded upon affidavits and old patents alone, where it is apparent that the claimed device of the patent is without patentable novelty or invention, has been followed as a matter of law and right in the Court of Appeals for the Second Circuit.

In the case of Curtis vs. Overman, 58 Fed. Rep., 532, the Court of Appeals found the patent invalid for want of patentable novelty, simply upon the old patents in the prior art, although the patent itself had been twice sustained at the Circuit in the absence of such prior art.

POINT VII.

If the decision of the Circuit Court of Appeals for the Seventh Circuit, upon the record, was a denial of justice, and the petitioner complainant is entitled to a trial upon full testimony taken; then this writ of certiorari not the procedure to assure this result.

It would seem to be quite clear, if the Court of Appeals for the Seventh Circuit has exceeded its authority, and has no jurisdiction to determine the question or questions that Court did determine in this case, without full proofs taken in deposition form, and re-

fuses so to do, that a petition for a writ mandamus, to compel that Court to proceed in due and orderly form is the right and remedy of the petitioner; and that the writ of *certiorari* is without right or contemplation of law for any such purpose.

POINT VIII.

The complainant petitioner's attempt to induce this Court to review and dissolve a preliminary injunction of the Circuit Court Judge preventing and enjoining petitioner from prosecuting the customers of the defendant for infringing this patent under bond given during the pending litigation; without semblance of right or justication.

It appears by Clause Fourteen of complainant petitioner's petition and brief that this Court is asked to set aside and dissolve an injunction granted by the Circuit Judge of the Seventh Circuit preventing it from suing and harassing customers of the defendant under suitable bond given during the pendency of this litigation, such clause of the complaint and order appearing on pages 8, 9 and 10 of the petition.

By what right or authority complainant petitioner imposes his complaint and grievance upon this Court in this matter we fail to understand or appreciate. The injunction there appearing was made on the 11th day of February, 1898, by the Circuit Judge. Under the same act by which the body of the case itself was lodged in the Circuit Court of Appeals, the complainant petitioner had a perfect right to appeal from the

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granting of such injunction to the Circuit Court of Appeals for the Seventh Circuit; but, on the contrary, no such appeal was taken, and such injunction was acquiesced in by the complainant petitioner and recognized; and by what law or authority complainant petitioner expects to skip the Circuit Court of Appeals for the Seventh Circuit, and ask or expect this Court to pass upon that question, we are at loss to appreciate or understand, and believe such contention to be simply an absurdity.

CONCLUSION.

We do not understand that we are called upon or expected by this Court, at this time, to go into any extended discussion of the record of this case, or to proceed to analyze or present any of the old patents and publications referred to by the Court of Appeals for the Seventh Circuit in their opinion, and as controlling and determining the same. We understand it to be our privilege and duty only, at this time, to point out to the Court such salient facts and conditions present without contention in this record, upon which this Court can easily see, without going into the record as to those matters, that there can be no ground upon the part of the petitioner appellant for the granting of the writ of *certiorari* in its behalf, as prayed for in its petition. And to this end we have briefly marshaled, in crystallized form, our principal several points of objection to the granting of this petition, and, briefly, our reasons therefor.

Respectfully submitted,

CHARLES K. OFFIELD,
CHARLES C. LINTHICUM.

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